ARGUMENTS

Applicants note that only claims 5-13 are pending in this application, although the Office Action of February 11, 2004 lists claims 5-14.

All the pending claims stand rejected in the Office Action as being unpatentable under 35 USC §103(a) over the disclosure of Pham et al. (US 6,171,780). Applicants respectfully traverse this rejection on the grounds that the Office Action fails to establish a *prima facie* case of obviousness for any of the pending claims.

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. ... To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> MPEP §2142, interpreting 35 USC §103

The Office Action fails to establish a *prima facie* case of obviousness for at least two reasons. First, the Office Action fails to factually support a *prima facie* case because the rejection fails to address an important limitation of all the pending claims. All the pending claims require "a lid to prevent evaporation" (see independent claim 5), however the Office Action does not contain any mention of this limitation, much less any specific allegation that Pham et al disclose this limitation. For this reason alone, the Office Action fails to establish a *prima facie* case of obviousness, and Applicants are under no obligation to submit evidence of nonobviousness.

Secondly and independently, the rejection fails to allege any specific motivation for one of skill in the art to select any microtiter plate according to the instant claims from the vast number of possible microtiter plates disclosed by the combination of many overlapping, broad ranges described by Pham et al. As characterized by the Office Action, Pham et al teach "the frame can be made of a polymer, and the bottom made of polystyrene, glass or quartz, ... diameters for the well of about 0.2 to 50 millimeters, ... thickness for the base of about 10-1000 micrometers, ... [and] embodiments which provide an edge [of no particular size]." See page 3 of the Office Action. From these broad descriptions, the Office Action alleges that one of skill in the art would be motivated to prepare at

least one specific microtiter plate of the instant invention, which has a plastic body, a glass base of 0.07 to 0.2 mm thickness, a well diameter of 1.0 to 1.8 mm and a distance between the center of the outer wells and an edge of the glass base from 4 to 11 mm. Applicants have identified this specific combination of variables as providing a microtiter plate optimized for use with confocal optics. See page 2, lines 30-36, of the specification. However, the Office Action fails to provide any suggested reason that one of skill in the art would choose a combination of just the right portion of each of the broad ranges of materials or dimensions disclosed by Pham et al to arrive at the instantly claimed invention. Since the Office Action fails to identify a motivation for one of skill in the art to choose the particular combination of materials and dimensions of the instant invention, no *prima facie* case of obviousness has been established, and Applicants are under no obligation to submit evidence of nonobviousness.

Applicants respectfully submit that the application is now in condition for allowance and request prompt notice thereof.

Respectfully submitted,

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